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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/829,101

04/21/2004

William J. Lutkus

0275G-000915

5999

27572 7590 04/30/2007
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EXAMINER

MITCHELL, KATHERINE W

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

04/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/829,101

Applicant(s)

LUTKUS ET AL.

Examiner

Katherine W. Mitchell

Art Unit

3677

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

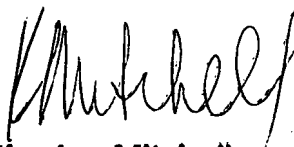


Katherine W Mitchell
Primary Examiner
Art Unit: 3677

Continuation of 11. does NOT place the application in condition for allowance because: examiner fully considered the declaration of Mr. Lutkus, but points out that the applied references, the Lutkus fastener of USP 6224311 and the Whitford paper, fully teach all the claimed limitations. Further, the Whitford Paper clearly states that non-chromate coatings are desirable to be used with fasteners for several reasons - to comply with European Union and major automobile manufacturer requirements to eliminate chromate-containing coatings, and that the chromate free coating also provides environmentally acceptable, corrosion resistant, and low friction coatings. Thus one of ordinary skill would be strongly motivated to use a chromate-free coating on the the Lutkus fastener of USP 6224311. Once one of ordinary skill in the art is so motivated and uses the chromate-free coating on the the Lutkus fastener of USP 6224311, one would inevitably recognize the other claimed advantages, and it does not matter that these other advantages are or are not unexpected. Again, the motivation to combine Lutkus 6224311 and the chromate free coating of the Whitford paper is to comply with production and environmental requirements - if major manufacturers and the entire European marketplace require chromate free coatings, suppliers are certainly motivated to provide such coatings to keep these customers, or at least still be a possible supplier. The Whitford paper provides numerous advantages (motivations) to use chromate-free coatings on fasteners--note the "outstanding and uniform torque/tension control", "superb" corrosion resistance, "unsurpassed" chemical resistance, along with ease of use and handling, and environmental advantages--Please see Figure copied on page 7 of final office action for further advantages of the non-chromate coating used on fasteners.

Once one is motivated to use chromate free coatings for environmental and marketing reasons, and does so, one would THEN inevitably realize any improved performance in the prevailing torque test, since identical structures perform identically.

Finally, examiner notes that applicant is arguing that the tangless inserts performed better than the tanged inserts, but the declaration provides absolutely no data on the tangless results - note that the only test results - Table 1 - are for tanged inserts. Regardless, it does not matter what other benefits are realized with chromate free coatings on the Lutkus fastener of 6224311, the Whitford paper provides overwhelming motivation to use chromate free coatings on fasteners, especially those to be used in automobiles, and any other benefits would be inevitably realized once the chromate-free coating was used.



Katherine Mitchell
Primary Examiner